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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/936,880	09/17/2001	Jurgen Hoser	02894-525001	9459

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EXAMINER

STINSON, FRANKIE L

ART UNIT PAPER NUMBER

1746

DATE MAILED: 03/02/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

09/936,880

Applicant(s)

HOSER ET AL. *sb*

Examiner

FRANKIE L. STINSON

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 22 December 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1 and 5-28 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1, 5-13, 15-23 and 25-28 is/are rejected.
- 7) ☒ Claim(s) 14 and 24 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_

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1. The indicated allowability of claims 10-18 is withdrawn in view of the newly discovered reference(s) to Klein et al. U. S. No. 4,351,733. Rejections based on the newly cited reference(s) follow.
2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

3. Claims 1, 5, 6, 7, 19, 27 and 28 are rejected under 35 U.S.C. 102(b) as being clearly anticipated by either Zademach, Taylor or Nicholoy.

Re claim 1, for example, note the cleaning liquid container (1 in Zademach, 37 in Taylor and 20 in Nicholoy) for cleaning a device (4/5/6 in Zademach, 8 in Taylor and 17 in Nicholoy), for cleaning an object, the liquid container comprising a housing defining an interior cavity; an inlet (as at 17/18 in Zademach, as at 39/40 in Taylor and as at 19 in Nicholoy), the inlet receiving a cleaning fluid carrying solid particles from the cleaning device into the interior cavity; an outlet (24 in Zademach, 47 in Taylor and 22 in Nicholoy) through which cleaning fluid is returned to the cleaning device for further cleaning of the object, a filter (24 in Zademach, 40/48 in Taylor and 34 in Nicholoy) arranged along a flow path of the cleaning fluid between the inlet and outlet; and an interior wall, (33 in Zademach, 38 in Taylor and 27/28 in Nicholoy) extending along the interior cavity, the interior wall being arranged to lengthen the flow path of the cleaning fluid between the inlet and outlet to promote settling of the solid particles carried by the cleaning fluid within the interior cavity. As for the intended use of cleaning an object of

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personal use namely a shaving apparatus as claimed in claim 19 27 and 28, please note the following from the MPEP, the intended use of the claimed invention must result in a structural difference between the claimed invention and the prior art in order to patentably distinguish the claimed invention from the prior art. If the prior art structure is capable of performing the intended use, then it meets the claim. In a claim drawn to a process of making, the intended use must result in a manipulative difference as compared to the prior art. See *In re Casey*, 152 USPQ 235 (CCPA 1967) and *In re Otto*, 136 USPQ 458, 459 (CCPA 1963).

APPARATUS CLAIMS MUST BE STRUCTURALLY DISTINGUISHABLE FROM THE

PRIOR ART>While features of an apparatus may be recited either structurally or functionally, claims< directed to >an< apparatus must be distinguished from the prior art in terms of structure rather than function. >*In re Schreiber*, 128 F.3d 1473, 1477-78, 44 USPQ2d 1429, 1431-32 (Fed. Cir. 1997) (The absence of a disclosure in a prior art reference relating to function did not defeat the Board's finding of anticipation of claimed apparatus because the limitations at issue were found to be inherent in the prior art reference); see also *In re Swinehart*, 439 F.2d 210, 212-13, 169 USPQ 226, 228-29 (CCPA 1971);< *In re Danly*, 263 F.2d 844, 847, 120 USPQ 528, 531 (CCPA 1959). "[A]pparatus claims cover what a device is, not what a device does." *Hewlett-Packard Co. v. Bausch & Lomb Inc.*, 909 F.2d 1464, 1469, 15 USPQ2d 1525, 1528 (Fed. Cir. 1990) (emphasis in original). Also in regard to claim 6, note that partial wall (the wall, unnumbered, which allows the overflow into chamber 24 in Zademach, 42 Taylor and 26 in Nicholoy).

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

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(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. Claims 8 and 9 are rejected under 35 U.S.C. 103(a) as being unpatentable over either Zademach, Taylor or Nicholoy in view of either Shoemaker et al. or Salzer et al.

Claim 8 defines over the applied prior art only in the recitation of the opening in the partial wall connecting a first chamber (20) with a second chamber (21). Shoemaker discloses a partial wall 12 having openings 28, 27. While Salzer discloses the walls 15, 16, 23 and 24 with openings over the top thereof. It therefore would have been obvious to modify the partial wall in either Zademach, Taylor or Nicholoy, to include a opening for connecting the first and second chamber as taught by Shoemaker or Salzer, for the purpose of ensuring a non-turbulent flow. Re claim 9, Salzer disclose the walls as ribs.

6. Claims 10-13 and 15-18 rejected under 35 U.S.C. 103(a) as being unpatentable over the applied prior art as applied to claims 1, 8, 9, 27 and 28 above, and further in view of Klein et al.

Claims 10 and 16 define over the applied prior art only in the recitation of ribs being provided on the inner walls. Klein discloses in a cleaning system, a settling tank where there is provided ribs on an interior wall (see fig. 2). It therefore would have been obvious to one having ordinary skill in the art to modify the device of either Zademach, Taylor or Nicholoy, to include a ribs as taught by Klein, for the purpose of enhancing the settling of the particles out of the fluid. Re claims 11-13, to employ one type of rib over the other is not deemed to structurally define over the applied prior art, see MPEP

2144.06 under "SUBSTITUTING EQUIVALENTS KNOWN FOR THE SAME

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PURPOSE". Re claim 15, Salzer disclose the comb-teeth as at 15. Re claims 17 and 18, Zademach discloses the inlet and outlet disposed adjacent to each other on a common wall.

7. Claims 20-23 and 26 are rejected under 35 U.S.C. 103(a) as being unpatentable over either Zademach, Taylor or Nicholoy in view of Klein et al.

Re claims 20 and 26, Zademach, Taylor and Nicholoy are each cited disclosing are cited as applied above and thusly, the claims define over the same only in the recitation of the ribs extending from an inner wall. Klein discloses the ribs (as applied to the same subject matter in paragraph 6 above). It therefore would have been obvious to one having ordinary skill in the art to modify the inner wall in either Zademach, Taylor or Nicholoy, to include ribs as taught by Klein, for the purpose of enhancing the removal of particulate debris. Re claims 21-24, to have the ribs arranged as claimed is deemed to be an obvious matter of design, see MPEP 2144.06 under "SUBSTITUTING EQUIVALENTS KNOWN FOR THE SAME PURPOSE".

8. Claim 25 is rejected under 35 U.S.C. 103(a) as being unpatentable over the applied prior art as applied to claim 20 above, and further in view of either Salzer et al. Claim 25 defines over the applied prior art only in the recitation of the partial wall having comb teeth. Salzer discloses in a cleaning liquid container, a partial wall having comb teeth as at 15. It therefore would have been obvious to one having ordinary skill in the art to modify the partial wall in either Zademach, Taylor or Nicholoy, to include comb teeth as taught by Salzer, for the purpose of enhancing the removal of particulate or floating debris.

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9. Claims 14 and 24 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.
10. Applicant's arguments with respect to claims 1 and 5-28 have been considered but are moot in view of the new ground(s) of rejection.
11. Any inquiry concerning this communication or earlier communications from the examiner should be directed to FRANKIE L. STINSON whose telephone number is (571) 272-1308. The examiner can normally be reached M-F from 5:30 a.m. to 2:00 p.m. and some Saturdays from 5:30 a.m. to 11:30 a.m.

The fax phone number for the organization where this application or proceeding is assigned is (703) 872-9306.

Any inquiry of a general nature or relating to the status of this application should be directed to TECHNOLOGY CENTER 1700 (571) 272-1700.

Any inquiry for missing parts of this Office Action (copies of references, pages, forms etc.), contact the TEAM LEADER Ms. Nicol Scott (571) 272-1045.

fls



FRANKIE L. STINSON  
Primary Examiner  
Art Unit 1746